



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,727	11/19/2001	Audrey Goddard	P2730P1C65	2390

35489 7590 07/12/2006

HELLER EHRMAN LLP
275 MIDDLEFIELD ROAD
MENLO PARK, CA 94025-3506

EXAMINER

ROMEO, DAVID S

ART UNIT	PAPER NUMBER
----------	--------------

1647

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/989,727	Applicant(s) GODDARD ET AL.	
	Examiner David S. Romeo	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 124-126, 129 and 135-138 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 124-126, 129 and 135-138 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/24/2006 has been entered.

Claims 124–126, 129 and 135–138 are pending and being examined.

Maintained Formal Matters, Objections, and/or Rejections:***Claim Rejections - 35 USC § 102***

Claims 124–126, 129, 135 and 137 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Applicants refer to a declaration of Dr. William Wood. The declaration of Dr. William Wood filed 04/24/2006 is insufficient to overcome the rejection of claims 124–126, 129, 135 and 137 based upon 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter as set forth in the last Office action because: Declarant argues that Incyte EST3476792 sequence did not encode for a full-length polypeptide because the Incyte sequence truncated before the nucleotides encoding for the stop codon of the polypeptide. Declarant's arguments have been fully considered but they are not persuasive. Declarant refers to the Incyte "sequence." A DNA "sequence" is merely descriptive of the linear order of monomers of which a DNA molecule is made and is not a DNA molecule. In Example 118 the specification states:

... the Incyte EST clone 3476792 was purchased and the cDNA insert was obtained and sequenced. It was found that this insert encoded a full-length protein. The sequence of this cDNA insert is shown in FIG. 265 and is herein designated as DNA60621-1516.

Art Unit: 1647

From the evidence provided it cannot be determined if the “sequence” referred to by declarant is a partial sequence of the cDNA insert or if it is the complete and entire sequence of the cDNA insert in the purchased clone. Therefore, it is appropriate to maintain the rejection. Applicants’ base their arguments on the declaration of Dr. Wood. Applicant’s arguments have been fully
5 considered but they are not persuasive because the declaration of Dr. Wood insufficient to overcome the rejection. Applicants’ disclosure amounts to a further characterization of a product not invented by applicants.

Applicants continue to refer to the sequence, whereas the evidence indicates that a clone was purchased. The examiner has tried to make it clear that a DNA sequence and a DNA
10 molecule/clone/cDNA are not the same thing. A statement such as “the Incyte EST sequence only disclosed an incomplete DNA sequence” does not carry the same weight as a statement such as “the cDNA insert in the purchased clone did not encode for a full-length polypeptide.” A statement that carries the same weight as “the cDNA insert in the purchased clone did not encode for a full-length PRO1186 polypeptide or said polypeptide lacking its signal peptide” may be
15 effective to overcome the rejection.

Double Patenting

Claims 124–126, 129 and 135–138 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-25 of copending Application No. 10/692,299. Applicants’ request to hold this rejection in abeyance is
20 acknowledged. However, there are no provisions for holding a rejection in abeyance.

Conclusion

No claims are allowable.

Art Unit: 1647

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

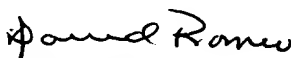
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (571) 272-0890. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M. IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, BRENDA BRUMBACK, CAN BE REACHED ON (571) 272-0961.

IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE CENTRAL FAX NUMBER FOR OFFICIAL CORRESPONDENCE, WHICH IS (571) 273-8300.

CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.


DAVID ROMEO
PRIMARY EXAMINER
ART UNIT 1647

DSR
JULY 9, 2006